

II. Claim Rejections under 35 U.S.C. § 102

A rejection under § 102 is only proper when the claimed subject matter, in this case a method of protecting keratinous fiber from extrinsic damage, is identically described or disclosed in the prior art. *In re Arkley*, 455 F.2d 586, 587 (CCPA 1972); *see also* M.P.E.P. § 706.02(a) ("For anticipation under 35 U.S.C. 102, the reference must teach every aspect of the claimed invention either explicitly or impliedly."). Importantly, each and every element of a claim must be set forth in the prior art reference for there to be anticipation. *See* M.P.E.P. § 2131.

Konishi

Claims 1 and 10-12 continue to be rejected under 35 U.S.C. § 102(b) as being anticipated by *Konishi* (JP 62099319) ("*Konishi*") for the reasons set forth on pp. 3-5 of the Final Office Action. Applicants respectfully traverse this rejection.

Applicants previously submitted that *Konishi*'s disclosure of a "hair tonic" does not clearly convey that the composition is applied to the hair. Reply dated August 8, 2002 at pp. 10-11. In the present Office Action, the Examiner states that because *Konishi* discloses applying compositions to the scalp, "application to the scalp would also incur application to hair and/or hair roots bearing hair." Final Office Action at p. 3.

Applicants continue to respectfully disagree. *Konishi* teaches that its tonic is useful for a "hair growth promoting effect." It is very well known that hair itself comprises dead cells. Dead cells cannot be affected by a hair growth formulation to stimulate hair growth. Thus, by disclosing a tonic for hair growth, *Konishi* teaches that its tonic should be applied to a region other than the hair. Thus, *Konishi* does not teach use of its tonic for protecting keratinous fiber from extrinsic damage.

Moreover, Applicants respectfully submit that *Konishi* does not inherently anticipate the present claims. It appears that the basis for this rejection lies in the possibility that “application to the scalp would also incur application to hair.” See Office Action at p. 3. “Inherency, however, may not be established by probabilities or possibilities. The mere fact that a certain thing may result from a given set of circumstances is not sufficient.” M.P.E.P. § 2112.

For at least these reasons, Applicants submit that *Konishi* does not identically describe the invention according to the present claims. Accordingly, Applicants respectfully request that this rejection be withdrawn.

Lekim

Claims 1 and 10-12 stand rejected under 35 U.S.C. § 102(b) as being anticipated by *Lekim* (DE 3901286) (“*Lekim*”) for the reasons set forth on pp. 3-5 of the Final Office Action. Applicants respectfully traverse this rejection.

The Examiner’s remarks on *Lekim* mirrors that for *Konishi*. Again, Applicants respectfully disagree. *Lekim* teaches the use of its hair tonic formulation for promoting “regeneration of hair on the head.” Thus, one would not apply the hair tonic to the hair itself, which comprises dead cells. Thus, *Lekim* teaches application to the scalp. Without a further disclosure that the hair tonic of *Lekim* is necessarily applied to the hair, *Lekim* fails to explicitly or impliedly disclose a method comprising application to keratinous fiber, as claimed.

For at least this reason, Applicants submit that *Lekim* does not identically describe the invention according to the present claims. Accordingly, Applicants respectfully request that this rejection be withdrawn.

III. Claim Rejections under 35 U.S.C. § 103

In order to establish a *prima facie* case of obviousness, the Examiner must demonstrate that there is some suggestion or motivation, either in the cited references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify a reference or combine reference teachings. See M.P.E.P. § 2143. Evidence of a suggestion or motivation to modify or combine references teachings must be "clear and particular." *In re Dembiczak*, 175 F.3d 994, 999 (Fed. Cir. 1999).

Konishi

Claims 1 and 10-12 stand rejected under 35 U.S.C. § 103(a) as being obvious over *Konishi* (JP 62099319) ("*Konishi*") for the reasons set forth on pp. 3-5 of the Final Office Action. Applicants respectfully traverse this rejection.

The Examiner supports the § 103 rejection on the basis that the composition of *Konishi* is similar to that of the present claims.

The Applicants submit that the Examiner has failed to provide a *prima facie* case of obviousness because *Konishi* fails to provide "clear and particular" evidence of a motivation to apply the composition to keratinous fiber, such as hair. If anything, by teaching a hair tonic for hair growth, *Konishi* explicitly directs one to apply its composition to the scalp, through which the composition can penetrate and act. A hair growth tonic is not effective when applied to the hair itself because it is well known that hair comprises dead cells. Because *Konishi* fails to teach or suggest applying the composition to keratinous fiber as claimed, a *prima facie* case of obviousness has not been established.

For at least this reason, Applicants submit that *Konishi* does not render obvious the present claims. Accordingly, Applicants respectfully request that this rejection be withdrawn.

Lekim

Claims 1 and 10-12 stand rejected under 35 U.S.C. § 103(a) as being obvious over *Lekim* (DE 3901286) ("*Lekim*") for the reasons set forth on pp. 11-12 of the present Office Action. Applicants respectfully traverse this rejection.

For the same reasons articulated for *Konishi* above, *Lekim* fails to provide the requisite "clear and particular" evidence of a teaching of applying hair tonic to the hair. It is counterintuitive to apply a hair growth tonic to a region, such as the hair, where it would be ineffective. Thus, the Examiner has failed to provide a *prima facie* case of obviousness of the presently claimed method.

For at least this reason, Applicants submit that *Lekim* does not render obvious the present claims. Accordingly, Applicants respectfully request that this rejection be withdrawn.

Konishi and Lekim in view of Pineau

Claims 1-8 and 10-13 are rejected under 35 U.S.C. § 103 (a) as being unpatentable over *Konishi* (JP 62099319) and *Lekim* (DE 3901286) in view of *Pineau et al.* (U.S. Patent No. 6,296,856) for the reasons set forth on pages 5-7 of the present Office Action. Applicants respectfully traverse this rejection.

The Examiner concedes that none of the references teach a method of applying a composition comprising the recited sugars and relies on *Pineau et al.* to provide a teaching of sugars. Office Action at p. 5. According to the Examiner, the rejection "is

based on the well established proposition of patent law that no invention resides in combining old ingredients of known properties where the results obtained thereby are no more than the additive effect of the ingredients" and cites *In re Sussman*. Office Action at p. 6.

Applicants respectfully submit that *Sussman* cannot be used to circumvent the requirement of a clear and particular evidence of a teaching or suggestion to combine references set forth in *Dembiczak*. No case citation can "outweigh the dozens of rulings of the Federal Circuit and the Court of Customs and Patent Appeals that determination of patentability must be based on evidence." See *In re Lee*, 277 F.3d 1338, 1345 (Fed. Cir. 2002). Since its publication in 1999, the Federal Circuit has relied on *Dembiczak* numerous times, as evidenced by the following exemplary citations:

Our case law makes clear that the best defense against hindsight-based obviousness analysis is the rigorous application of the requirement for a showing of a teaching or motivation to combine the prior art references. See *Dembiczak*, 175 F.3d at 999, 50 USPQ2d at 1617. "Combining prior art references without evidence of such a suggestion, teaching, or motivation simply takes the inventor's disclosure as a blueprint for piecing together the prior art *1372 to defeat patentability--the essence of hindsight." *Id.*

Ecolchem, Inc. v. Southern California Edison Company, 227 F.3d 1361, 1371-1372 (Fed. Cir. 2000).

A critical step in analyzing the patentability of claims pursuant to section 103(a) is casting the mind back to the time of invention, to consider the thinking of one of ordinary skill in the art, guided only by the prior art references and the then-accepted wisdom in the field. See *Dembiczak*, 175 F.3d at 999, 50 USPQ2d at 1617. Close adherence to this methodology is especially important in cases where the very ease with which the invention can be understood may prompt one "to fall victim to the insidious effect of a hindsight

syndrome wherein that which only the invention taught is used against its teacher." *Id.* (internal citation omitted).

In re Kotzab, 217 F.3d 1365, 1369 (Fed. Cir. 2000).

Although a reference need not expressly teach that the disclosure contained therein should be combined with another ... the showing of combinability, in whatever form, must nevertheless be "clear and particular." *Dembiczak*, 175 F.3d at 999, 50 USPQ2d at 1617.

Winner International Royalty v. Wang, 202 F.3d 1340, 1348-1349 (Fed. Cir. 2000).

Regarding the argument that the required motivation to combine may be found in the nature of the problem, Ficosa's argument is unpersuasive. The showing of a motivation to combine must be clear and particular, and it must be supported by actual evidence. *In re Dembiczak*, 175 F.3d at 999, 50 USPQ2d at 1617 (Fed. Cir. 1999).

Teleflex, Inc. v. Ficosa North America Corp., 299 F.3d 1313, 1334 (Fed. Cir. 2002).

In re Dembiczak, 175 F.3d at 999, 50 USPQ2d at 1617 (Fed. Cir. 1999). ("Our case law makes clear that the best defense against the subtle but powerful attraction of a hindsight-based obviousness analysis is rigorous application of the requirement for a showing of the teaching or motivation to combine prior art references.")

In re Lee, 277 F.3d 1338, 1343 (Fed. Cir. 2002).

Konishi and *Lekim* teach the benefit of a willowherb extract whereas *Pineau* describes a composition comprising sugars. There is no suggestion or motivation provided in the references for combining the two ingredients. Applicants respectfully submit that the *Dembiczak* standard has not been met here. Thus, a *prima facie* case of obviousness has not been established.

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Accordingly, for at least the foregoing reasons, Applicants respectfully request that this rejection be withdrawn.

IV. Provisional Double Patenting Rejection

Claims 1-13 remain provisionally rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1-13 of copending Application No. 09/527,599 for the reasons set forth on pp. 7-8 of the present Office Action. Applicants respectfully traverse this rejection, but, at this time, respectfully request that this rejection be held in abeyance until allowable subject matter is indicated. At that time, Applicants will consider whether or not to file a Terminal Disclaimer.

V. Conclusion

In view of the foregoing remarks, Applicants respectfully request reconsideration and reexamination of this application and the timely allowance of the pending claims.

Please grant any extensions of time required to enter this response and charge any additional required fees to Deposit Account No. 06-0916.

Respectfully submitted,

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